

REMARKS

Claims 1-12 and 14-19 remain pending in this application. Claims 10-12 and 14-16 have been withdrawn from consideration as being directed to a non-elected invention.

Claim 1 has been amended to more particularly point out that a photopolymer plate comprises a photopolymer which is considered self-evident, but it does provide explicit antecedent support for “photopolymer” recited in claim 2. Support for this amendment can be found in the examples, for example, starting at page 39 of the specification, wherein a photopolymer plate is made by applying a photopolymer to a substrate. Claim 2 has been amended to more particularly point out that the binder polymer comprises a mixture of a polar group-containing polymer and a hydrophobic polymer. Support for this amendment can be found, for example, at page 13, lines 16-25. Accordingly, no new matter has been introduced by these amendments.

Rejection: §112, 2nd paragraph

Claims 1-9 and 17-19 have been rejected under 35 USC §112, second paragraph, as being indefinite for several reasons that will be addressed in the order of their appearance in the Office action.

A. The claims have been rejected because the language “selected from” recited in claims 1 and 3 is allegedly improper Markush claim language - the Examiner stated that the claims should recite “selected from the group consisting of.” While it can be acknowledged that the recited language “selected from” is not the phrase associated with the Markush decision, there is nothing improper or indefinite with the recited language “selected from,” and a Markush phrase is not required when reciting

alternative embodiments. It has long been recognized that it is appropriate to claim an element in a claim by referring to alternative embodiments. See MPEP 2173.05(h).

Claim 1 identifies a group of alternative reactive functional groups that is/are used to modify the recited silicone compound. As this language is clear and definite, this rejection should be withdrawn.

B. Claim 2 was rejected as being indefinite because the Examiner is under the mistaken impression that the binder polymer should be called a copolymer. However, the binder polymer is not a copolymer, but rather a mixture of polymers as reference to page 13, lines 16-25 of the specification will support. In order to improve the clarity of this claim, it has been amended to recite that the binder polymer comprises a mixture of polymers. Accordingly, this rejection should be withdrawn.

C. Claim 2 also has been rejected as indefinite as there is allegedly no antecedent basis for “photopolymer” in claim 1. It is respectfully submitted that a photopolymer plate necessarily means that the plate for letterpress printing recited in claim 1 includes a photopolymer. Nevertheless, solely to advance prosecution of this application, claim 1 has been amended to recite that the photopolymer plate comprises a photopolymer. Accordingly, this rejection should be withdrawn.

Rejection: § 103

Claims 1, 3-9 and 17-19 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Fuji (U.S. 2002/0182543 A1) in view of Wallbillich (U.S. Patent No. 4,876,118). The teachings of Fuji have been discussed earlier in the examination of this application, and the Examiner has acknowledged that Fuji does not disclose a contact step that brings the photopolymer plate into contact with a silicone or fluorine compound

within the scope of the present claims. Fuji does disclose a developing liquid that is brought into contact, typically by spraying onto the photopolymer plate - see paragraphs 0009, 0037, 0045 and Example 1, for example. Fuji cautions against the introduction of ingredients that will impair the effect of that invention.

The Office now relies on the teachings of Wallbillich to show that it is old to contact a gravure printing plate with a silicone compound that is said to be similar to that recited in the present claims. The Office concludes that it would be obvious to modify the developing solution of Fuji to contain a silicone compound taught in Wallbillich to aid in eliminating damages to the printing plate and undesirable impressions. Applicants disagree because the proposed addition would render the printing plate of Fuji unsatisfactory for its intended purpose.

Wallbillich relates to a method for the negative correction of gravure printing plates by filling undesirable depressions in the printing layer with a correcting agent (see col. 1, lines 5 to 11). Undesirable depressions in the printing plate surface, for example defective wells as well as scratches, scrapes, holes or other damage to the printing plate surface, which may occur during the printing process, will likewise be filled with "a pasty material which is viscoplastic at room temperature and is based on a specific fluorinated olefin polymer powder" during inking of the gravure printing plate and will consequently be prevented from being printed during the printing process (see col. 1, lines 22 to 29).

The Examiner alleges that the teachings of Fuji can be combined with the teachings of Wallbillich. However, the "pasty material which is viscoplastic at room temperature and is based on a specific fluorinated olefin polymer powder" of Wallbillich

must "have no affinity for the gravure printing inks, permitting the surface ink to be removed easily by means of doctor blade" (see col. 4, lines 36 to 38). In other words, the pasty material of Wallbillich must be "completely resistant to the printing ink solvents" (see column 4, lines 33 to 34).

Fuji teaches that a detergent or the like is preferably contained in a developing agent. However, the detergent contained in the developing agent is sprayed on the entire plate, not only the non-printing surface of the printing plate, but also the printing surface that is necessary to be filled with ink during the printing process. Since the fluorinated olefin polymer of Wellbillich is resistant to the printing ink, it would act to destroy the printing surface to accept ink if it were added to the developing liquid taught by Fuji, and render it unsatisfactory for its intended purpose. This is clearly a situation where the art teaches away from the addition of the silicone compound of Wallbillich to the developing liquid of Fuji. Where the proposed modification would render the printing plate of Fuji unsatisfactory for its intended purpose, there is no suggestion or reason to make the proposed modification that can support a conclusion of obviousness. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). See also MPEP 2143.01(v). Accordingly, this rejection should be withdrawn.

Prompt and favorable reconsideration is requested.

Please grant any extensions of time required to enter this response and charge
any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 8, 2010

By: Charles E. Van Horn
Charles E. Van Horn
Reg. No. 40,266
(202) 408-4000